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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,192	06/07/2002	Erich Bayer	218083US6PCT	8698

22850 7590 04/23/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

TRAN, SINH N

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 04/23/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary

Application No.

10/030,192

Applicant(s)

BAYER, ERICH

Examiner

Sinh Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-21 is/are pending in the application.
- 4a) Of the above claim(s) 22-29 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-21 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's election with traverse of claims 15-21 and 30 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that the search area would overlap, therefore the entire application can be made without serious burden on the examiner. Even though the search areas for the species are overlapping, the species are independent and patentably distinct and would impose a serious burden on the examiner. Therefore, applicant's argument is not persuasive.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 15-16 and 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Henderson (U.S. 2,939,923) or DE 3826897 (cited by the applicant).

Regarding claims 15-16, Henderson or DE discloses an earpiece (earpiece shown in Fig. 8; 3 Of Fig. 1; respectively) by which a signal conductor (315; 2) that comes from the BTE device (17; 1) can be positioned in an auditory canal, the earpiece having a shape of a clip, configured to follow an outer edge of the patient's conchae in an arc shape, at least in segments (154, 155; 8, 9), wherein a shank that follows the outer edge of the cavum conchae makes a transition, above the patient's antitragus, into an angled traverse segment that passes through the

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cavum conchae, which runs in a direction of the patient's porus acusticus externus, and broadens to hold the signal conductor at its end segment, which comes to rest in an upper region of the auditory canal (Fig. 8; Fig. 2).

Regarding claims 20-21, Henderson further discloses an additional shank (shank that extends between shanks 154 and 155; 3).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson or DE 3826897.

Henderson or DE fails to disclose that the earpiece is for use with CI BTE processors. Official Notice is taken that cochlear implant BTE processors are usually mounted or hooked on or near the ear. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the earpiece of Henderson or DE for use with any other BTE devices including the CI BTE processors so as to provide a better hold for the device on the ear.

6. Claims 15-21 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 29718483 cited by the applicant.

Regarding claims 15-20 and 30, DE 29718483 discloses an earpiece (14) by which can be positioned in an auditory canal, the earpiece having a shape of a clip, configured to follow an outer edge of the patient's conchae in an arc shape, at least in segments (14), wherein a shank that follows the outer edge of the cavum conchae makes a transition, above the patient's antitragus, into an angled traverse segment that passes through the cavum conchae, which runs in a direction of the patient's porus acusticus externus, and broadens at its end segment, which comes to rest in an upper region of the auditory canal (see Figs. 1 and 5-8). DE fails to specifically teach that the earpiece is for holding the signal conductor of a BTE device. However, DE did teach that the earpiece is for attachment of optological devices, e.g. hearing aids, tinnitus masks and noise generators. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the earpiece would be used to provide a hold for the conductor to the ear if the desired optological device is a BTE, a cochlear implant or BTE with tinnitus system.

Regarding claim 21, DE further discloses an additional shank (15).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sinh Tran whose telephone number is (703) 305-4040. The examiner can normally be reached on M,T&Th 9:00AM-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (703) 305-4708. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks

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Washington, D.C. 20231

or faxed to:

(703) 872-9314, for formal communications intended for entry and for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Sinh Tran
Primary Examiner
Art Unit 2643

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April 19, 2003